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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,228	09/13/1999	GLENN PETKOVSEK	P-99-012	3917

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/394,228

Applicant(s)

PETKOVSEK, GLENN

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-23 is/are allowed.
- 6) ☒ Claim(s) 1-12, 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3, 8, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable

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over Walz (5,664,725) in view of Schwan et al (5,524,934).

Walz discloses in Fig. 1, 4 and 5, a mailing assembly and a method of preparing a mailpiece comprising a label (10) having a front side (Fig. 1) and an opposite and juxtaposed or abutting backside (Fig. 5) wherein the label (10) includes a single-layered postcard (which is the area (A) defined between perforated lines 24 and 26, Col. 4, lines 40-53) and an integrally formed designator section (73) that is contained within the exterior sides (24a and 26a), a first and second anchor portion (58 and 59) having an adhesive (16) on the backside, and a backing strip (49) disposed over the adhesive on the backside of the anchor (seen in Fig. 5); and wherein the backside includes indicia (Col. 4, lines 40-58).

However, Walz does not disclose: a designator section indicative of a special service; and a label including shading and printing wherein the shading and printing are a single color.

Schwan et al discloses in Fig. 2, 3 and 5, a record in the form of a label (Col. 1, lines 10 and 11; and Col. 7, lines 14-16) having selected portions for forming areas of a plurality of different colors, wherein coatings of colorless color formers and developers are initially combined (upon application of an imaging force) to form colored visible areas (Fig. 3 and 4). The coatings (color formers and color developers) can be applied in selected areas on the label, and when combined can form blocks of background color(s) or may be applied so as to form symbols or indicia (Col. 4, lines 58-61 and Claims 1-3), both in many different shades or hues (Col. 4, lines 14-20).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walz's label to include a label having self contained ink coatings to form a shading and printing of a particular color as set forth by Schwan et al for the purpose of providing an advantage that both information and colored areas on a document can be achieved by printing in a single pass through a thermal or impact printer and further wherein the colored label can be used as an indication of where the label and its accompanying contents are to be routed.

In regards to **Claims 9 and 11**, the method for preparing a mail piece for delivery by providing a label having a front side and a back side, wherein the label includes a postcard and an integrally formed designator section that is contained within exterior sides that defines the return postcard; providing one anchor on an exterior side of the postcard, wherein the anchor portion has a backside, and further wherein the backside includes adhesive. Furthermore, Walz teaches the method step of removing a backing strip (49) disposed over the adhesive (as seen in Fig. 5); an attaching the label to a mail piece (Col. 4, lines 63-67 and Col. 5, lines 1-3); and printing information on the return postcard relating to delivery of the mail piece by a special service (Col. 4, lines 35-53).

Furthermore in regards to **Claim 9**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the shading and printing at any location on the label, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore, it would be obvious to place the shading and printing at any desired location

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since applicant has not stated why it would be critical to place the shading and printing at a particular location or side.

In regards to **Claim 1, 9 and 11**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section and postcard, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. Further, in regards to the designator section being indicative of a special service, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the designator section of the Walz reference is capable of being indicative of special service.

2. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walz (5,664,725) in view of Schwan et al (5,524,934) and further in view of Fabel (5,836,622).

Walz as modified Schwan et al discloses a mailing assembly and method of preparing a mail piece comprising all the elements as set forth in Claim 1, and as set forth above.

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However, Walz does not disclose wherein the designator section has a machine readable code.

Fabel discloses in Col. 10, lines 36-43, wherein the designator section (158) has a machine readable code area.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walz's and Schwan et al's mailing assembly with a designator section having a machine readable code as taught by Fabel for the purpose of providing additional identifying information.

3. Claims 4-6, 10, 12, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walz in view of Schwan et al, and further in view of Petkovsek (5,697,648).

Walz as modified Schwan et al discloses a mailing assembly and method of preparing a mail piece comprising all the elements as set forth in Claims 1 and 9, and as set forth above.

However, Walz does not disclose a printer track strip associated (Webster Dictionary defines as "combined") extending outside the exterior sides of the postcard wherein the strip includes a hole and is removably attached to the anchor portion.

Petkovsek discloses in Fig. 5, a mailing assembly having a label sheet (11) having a width between a first end (E1) and a second end (E2); wherein the first end has a printer track strip (56)

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with holes (54) extending outside the exterior sides of the postcard (18) at one end of the assembly (E1) and is removably attached (perforations) to the anchor portion (28)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walz's and Schwan et al's mailing assembly with a printer track strip extension associated with the label as taught by Petkovsek for the purpose of allowing the mailing assembly to be passed through a printer.

***Allowable Subject Matter***

4. Claims 13-23 are allowed.

5. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses or fairly suggests a mailing assembly comprising a plurality of labels removably attached and includes a postcard, a designator section, and a printer track strip associated with each label wherein the printer tracking strip includes a first hole and each label has a second hole.



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***Response to Arguments***

6. Applicant's arguments filed on October 16, 2003 have been fully considered but they are not persuasive.

In regards to applicant's argument that neither the Walz or Schwan et al reference teaches a label which has a front side and a backside, and includes a return postcard formed with a designator section indicative of a special service, the examiner submits that the Walz does indeed disclose a label comprising a front side, a back side, and an integrally formed postcard with a designator section; and wherein the label has printed indicia on the front and back sides of the label. However, the Walz reference does not disclose a designator section indicative of special services; and wherein the label includes printing and shading of a single color on the front and back sides. The Schwan et al reference is cited for disclosing a label having a surface for forming background color(s) or symbols or indicia of a single color. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walz's label to include a label having self contained ink coatings to form a shading and printing of a particular color as set forth by Schwan et al for the purpose of providing an advantage that both information and colored areas on a document can be achieved by printing in a single pass through a thermal or impact printer and further wherein the colored label can be used as an indication of where the label and its accompanying contents are to be routed. The applicant must further note that the claim limitation "wherein the shading and printing are a single color" does not mean that

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the colors are the same. If this is what applicant meant to say, then the claim limitation must disclose that the colors of the shading and printing are the same color.

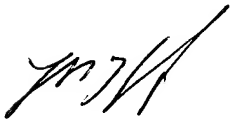
In regards to applicant's argument that the Petkovsek reference can not be combined with Walz or Schwan et al, the examiner submits that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Walz as modified by Schwan et al discloses a mailing assembly comprising all the elements as disclosed in Claims 1 and 9. However, Walz does not disclose a label having a printer track strip associated (combined) with the label. Petkovsek discloses in Fig. 5, a mailing assembly having a label sheet (11) having a width between a first end (E1) and a second end (E2); wherein the first end has a printer track strip (56) with holes (54) extending outside the exterior sides of the postcard (18) at one end of the assembly (E1) and is removably attached (perforations) to the anchor portion (28).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walz's and Schwan et al's mailing assembly with a printer track strip associated with the label as taught by Petkovsek for the purpose of allowing the mailing assembly to be passed through a printer.

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

November 21, 2004



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